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EXAMINER

PORTER, RACHEL L

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PAPER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* THOMAS D. DOERR.
9 KEVIN STEHLIN,
10 RICHARD REICHLEY,
11 and MICHELLE HADLEY
12

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14 Appeal 2009-000981
15 Application 09/825,969
16 Technology Center 3600
17

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19 Decided: August 24, 2009
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22 *Before* MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU
23 R. MOHANTY, *Administrative Patent Judges*.

24
25 CRAWFORD, *Administrative Patent Judge*.
26

27
28 DECISION ON APPEAL
29 STATEMENT OF THE CASE

30 Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection
31 of claims 1-9 and 12-22. We have jurisdiction under 35 U.S.C. § 6(b)
32 (2002).

Appellants invented a system and method including a patient-side decision support system having a hand-held terminal usable during examination and providing a display and user input device (Spec. [0008]).

Claim 1 under appeal is further illustrative of the claimed invention as follows:

1. A point-of-care decision support system comprising:
 - a hand-held terminal usable during examination and providing a display and physician input device;
 - a terminal server communicating with the hand-held terminal and executing a stored program to:
 - (a) present on the display of the hand-held terminal a navigation menu presenting diagnosis codes representing different medical diagnoses and, wherein the navigation menu is configured to restrict access to additional support features related to a treatment of a medical diagnosis represented by the specific diagnosis code until a diagnosis code is selected;
 - (b) accept from the physician input device of the hand-held terminal a selection identifying a specific diagnosis code from the diagnosis codes; and
 - (c) enable access to additional physician support features related to a treatment of a medical diagnosis represented by the specific diagnosis code in response to the selection identifying the specific diagnosis code.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Mayaud	US 5,845,255	Dec. 1, 1998
Evans	US 5,924,074	Jul. 13, 1999
Lewis	US 2003/0200119 A1	Oct. 23, 2003
Denny	US 6,687,676 B1	Feb. 3, 2004

Yvonne L. Lee, *Fujitsu Pen Computer Will Ship with Windows 95*, 18 InfoWorld, 30 (1996)(hereinafter "Lee").

The Examiner rejected claims 1, 4-9, 12, and 14-19 under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of Lewis; claims 2-3 under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of Lewis and Denny; claims 13 and 21-22 under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of Lewis and Mayaud; and claim 20 under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of Lewis and Lee.

We AFFIRM.

ISSUES

Did the Appellants show the Examiner erred in finding that modifying the point of care system of Evans to include the constraint system of Lewis renders obvious a display on a hand-held terminal including a navigation menu configured to restrict access to additional support features related to a treatment of a medical diagnosis represented by the specific diagnosis code until a diagnosis code is selected, as recited in independent claim 1, because Evans teaches away from the diagnosis code serving as a gatekeeper to additional information?

Did the Appellants show the Examiner erred in finding that the domain names of Evans correspond to the hyperlinks to other physician educational information, as recited in dependent claim 5?

Did the Appellants show the Examiner erred in finding that a combination of Evans and Denny renders obvious printing patient handouts about at least one of the diagnosis represented by the specific diagnosis code and the treatment of the medical diagnosis, as recited in dependent claim 2, and printing a prescription for the treatment of the medical diagnosis, as recited in dependent claim 3?

1 Did the Appellants show the Examiner erred in finding that a
2 combination of Evans, Lewis, and Mayaud renders obvious the subject
3 matter of dependent claims 13, 21, and 22, because Mayaud does not remedy
4 the deficiencies of independent claim 1 concerning restricting access based
5 on diagnosis code entry?

6
7 FINDINGS OF FACT

8 *Specification*

9 Appellants invented a system and method including a patient-side
10 decision support system having a hand-held terminal usable during
11 examination and providing a display and user input device (Spec. [0008]).

12
13 *Evans*

14 Evans discloses point of care system 100 including optional practice
15 guideline 149 that supplements the structure of point of care system 100.
16 Optional practice guidelines 149 provides references for practitioners to
17 consult regarding courses of action to obtain a diagnosis and alternative
18 treatments for various conditions (col. 7, ll. 52-57).

19 Diagnosis module 300 allows a physician to enter selected diagnosis
20 codes to diagnosis selection box 337 (col. 11, ll. 37-50).

21 A healthcare provider may remotely access a patient record resident in
22 server 414 located at a geographically distant location using web browser
23 412, for example, by accessing the Wide Area Network (WAN) by entering
24 appropriate domain names (col. 13, ll. 20-30).

1 *Lewis*

Lewis discloses constraint engine 82 that takes the user's ICD9 code selections and returns to the anatomic user interface 58 only those CPT codes that are valid for or "constrained to" those ICD9 codes. In other words, for a particular group of diagnoses, the constraint engine 82 returns only those healthcare services that are appropriate for the medical diagnoses associated with the anatomic structure to be treated and the user is only allowed to order those healthcare services using the proper CPT codes assigned to those services ([0083]).

10 Constraint engine 82 prevents the patient's insurance company from
11 rejecting the order based upon improper code or based upon improper
12 assignment of healthcare services to medical diagnoses ([0083]).

13

14 *Denny*

15 Denny discloses printing out prescription information, including the
16 unique code generated by host system 12, on printer 46. The printout may
17 then be presented to the patient (col. 6, ll. 51-55).

18

19 PRINCIPLES OF LAW

20 *Obviousness*

21 A reference may be said to teach away when a person of ordinary
22 skill, upon examining the reference, would be discouraged from following
23 the path set out in the reference, or would be led in a direction divergent
24 from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551,
25 553 (Fed. Cir. 1994).

1 During examination, the examiner bears the initial burden of
2 establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d
3 1443, 1445 (Fed. Cir. 1992).

4 Once a prima facie case of obviousness is established, the burden
5 shifts to Appellants to rebut it. *In re Keller*, 642 F.2d 413, 425 (CCPA
6 1981).

7 One cannot show non-obviousness by attacking references
8 individually where the rejections are based on combinations of references.
9 *Id.* at 426.

11 *Claim Construction*

12 While the specification can be examined for proper context of a claim
13 term, limitations from the specification will not be imported into the claims.
14 *CollegeNet, Inc. v. ApplyYourself, Inc.*, 418 F.3d 1225, 1231 (Fed. Cir.
15 2005).

17 *Inherency*

18 To establish inherency, the extrinsic evidence must make clear that
19 the missing descriptive matter is necessarily present in the thing described in
20 the reference, and that it would be so recognized by persons of ordinary
21 skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

23 ANALYSIS

24 *Restrict Access*

25 We are not persuaded of error on the part of the Examiner by
26 Appellants' argument that because Evans teaches away from the diagnosis

1 code serving as a gatekeeper to additional information because the point of
2 care system of Evans would not be modified to include the constraint system
3 of Lewis to render obvious a display on a hand-held terminal including a
4 navigation menu configured to restrict access to additional support features
5 related to a treatment of a medical diagnosis represented by the specific
6 diagnosis code until a diagnosis code is selected, as recited in independent
7 claim 1 (App. Br. 3-6). Specifically, Appellants assert that because Evans
8 discloses both the diagnosis code and the reference database simultaneously,
9 and the physician is able to freely select any option on either database, that
10 Evans teaches away from being combined with the constraint engine of
11 Lewis. However, Evans does not discourage limiting the physician's
12 options. *See In re Gurley*, 27 F.3d at 553. Indeed, because the diagnosis
13 codes are optional, Evans contemplates restricting a physician's options, in
14 this case, by eliminating diagnosis codes. While in the context of Evans,
15 independent claim 1 would be directed to restricting access to the reference
16 database, and not diagnosis codes, because Evans is merely silent about and
17 does not discourage restricting access to the reference database, there is no
18 teaching away.

19 Evans discloses point of care system 100. Lewis discloses constraint
20 engine 82. The reason to combine, as set forth in paragraph [0083] of
21 Lewis, is to ensure that a user is allowed to order the most appropriate
22 healthcare treatments/services corresponding to the diagnosis, leading to
23 fewer problems in claims processing by health insurers (Ex. Ans. 11-14).
24 *See In re Oetiker*, 977 F.2d at 1445. As the Examiner has established a

1 proper case of prima facie obviousness, and the Appellants have not
2 persuasively rebutted the prima facie case, we will sustain this rejection. *See*
3 *In re Keller*, 642 F.2d at 425.

4
5 *Hyperlinks*

6 We are not persuaded of error on the part of the Examiner by
7 Appellants' argument that the domain names of Evans do not correspond to
8 the hyperlinks to other physician educational information, as recited in
9 dependent claim 5 (App. Br. 6-7). While Evans only explicitly discloses
10 domain names, it is inherent that once a healthcare provider gains access to
11 WAN 402 on server 414 via web browser 412, the healthcare provider will
12 need to navigate WAN 402 via hyperlinks to access other information. *See*
13 *In re Robertson*, 169 F.3d at 745.

14 Insofar as the rationale for the basis of this rejection may differ from
15 that set forth by the Examiner, we denominate our affirmance of the
16 rejection of this claim as a new ground of rejection under 37 C.F.R. §
17 41.50(b) (2008).

18
19 *Printing Handouts and Prescriptions*

20 We are not persuaded of error on the part of the Examiner by
21 Appellants' argument that a combination of Evans and Denny does not
22 render obvious printing patient handouts about at least one of the diagnosis
23 represented by the specific diagnosis code and the treatment of the medical
24 diagnosis, as recited in dependent claim 2, and printing a prescription for the
25 treatment of the medical diagnosis, as recited in dependent claim 3 (App. Br.
26 7-8). For the argument that Evans does not disclose or suggest that access to

1 additional support features is restricted until selection of a diagnosis code is
2 entered, please see the analysis for independent claim 1. Moreover, we note
3 that Lewis, and not Evans, is cited for disclosing constraint engine 82. *See*
4 *In re Keller*, 642 F.2d at 426 (one cannot show non-obviousness by
5 attacking references individually where the rejections are based on
6 combinations of references).

7 The Appellants argue that Denny does not disclose diagnosis codes.
8 However, Evans is cited as disclosing diagnosis codes. *See Id.* The
9 Appellants also argue that Denny does not disclose the ability to print
10 handouts or printed prescriptions only after the entry of a diagnosis code.
11 First of all, such an aspect is not set forth in the claims. *See CollegeNet, Inc.*
12 *v. ApplyYourself, Inc.*, 418 F.3d at 1231. Secondly, even if such an aspect
13 were set forth in the claims, the Appellants have not persuasively shown
14 how the Examiner erred in combining Evans and Lewis to render obvious
15 restricting access to certain options. Denny discloses the printing option at
16 Col. 6:51-55. Accordingly, as the Appellants have not persuasively shown
17 how the Examiner erred in combining Evans, Lewis, and Denny to render
18 obvious the option of printing handouts or printed prescriptions only after
19 the entry of a diagnosis code, we will sustain this rejection.

20
21 *Dependent Claim 13, 21, and 22*

22 We are not persuaded of error on the part of the Examiner by
23 Appellants' argument that a combination of Evans, Lewis, and Mayaud does
24 not render obvious the subject matter of dependent claims 13, 21, and 22,
25 because Mayaud does not remedy the deficiencies of independent claim 1
26 concerning restricting access based on diagnosis code entry (App. Br. 8-9).

1 As set forth above with respect to independent claim 1, a combination of
2 Evans and Lewis has been set forth as rendering obvious restricting access
3 based on diagnosis code entry. Accordingly, because there is no need for
4 Mayaud to remedy this deficiency, we will sustain the rejections of
5 dependent claims 13, 21, and 22.

6
7 CONCLUSION OF LAW

8 On the record before us, Appellants have not shown that the Examiner
9 erred in rejecting claims 1-9 and 12-22.

10
11 DECISION

12 The decision of the Examiner to reject claims 1-9 and 12-22 is
13 affirmed.

14 We use our authority under 37 C.F.R. § 41.50(b) to enter a new
15 rationale for rejecting claim 5 under 35 U.S.C. § 103(a) as unpatentable over
16 Evans in view of Lewis.

17 37 C.F.R. § 41.50(b) provides that, “[a] new ground of rejection
18 pursuant to this paragraph shall not be considered final for judicial review.”

19 Regarding the new ground of rejection, Appellants must, WITHIN
20 TWO MONTHS FROM THE DATE OF THE DECISION, exercise one of
21 the following options with respect to the new ground of rejection, in order to
22 avoid termination of the appeal as to the rejected claims:

23 (1) *Reopen prosecution*. Submit an appropriate amendment of the
24 claims so rejected or new evidence relating to the claims so rejected,
25 or both, and have the matter reconsidered by the examiner, in which
26 event the proceeding will be remanded to the examiner. . . [; or]

1 (2) *Request rehearing*. Request that the proceeding be reheard under
2 § 41.52 by the Board upon the same record. . . .

3 No time period for taking any subsequent action in connection with
4 this appeal may be extended under 37 C.F.R. § 1.136(a) (2007).

5

6 AFFIRMED, 37 C.F.R. § 41.50(b)

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